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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/555,592	09/20/2000	Oyvind Breivik	28170-00020	1082
7590	11/14/2003		EXAMINER	
Stanley R Moore Jenkens & Gilchrist 1445 Ross Avenue Suite 3200 Dallas, TX 75202-2799			WONG, BLANCHE	
			ART UNIT	PAPER NUMBER
			2667	
DATE MAILED: 11/14/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/555,592	BREIVIK ET AL.	
	Examiner	Art Unit	
	Blanche Wong	2667	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM
 THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on ____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) Claim(s) ____ is/are allowed.
- 6) Claim(s) 1-7 is/are rejected.
- 7) Claim(s) 8-10 is/are objected to.
- 8) Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on ____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on ____ is: a) approved b) disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All
 - b) Some *
 - c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. ____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) Interview Summary (PTO-413) Paper No(s) ____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, an IN [service] prefix as cited in claim 1, and lists of gateways, IP addresses and area codes as cited in claim 7, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to under 37 CFR 1.83(a) because they fail to show a one-step procedure and a process for finding the most appropriate gateway(s), as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

3. Applicant is required to submit a proposed drawing correction in reply to this Office action. However, formal correction of the noted defect may be deferred until after the examiner has considered the proposed drawing correction. Failure to timely submit the proposed drawing correction will result in the abandonment of the application.

4. It is noted in Fig. 2 that "in practice, the database may be located in any part of the system, preferably in conjunction with the gateway. In another preferred embodiment, the database is connected to an intelligent network . . ." PCT/FI96/00568 included by the applicant, p. 7, ln. 14-16. Szviatovszki et al. (U.S. Pat No. 6,470,010) (PCT/SE96/00680 included by the applicant) discloses an IN 1 in between the telephone network 2 and gateway 4 like the invention at hand. In the IN, the telephone network is connected to the SSP 12 and the SSP is connected to the SCP 13. Szviatovszki shows a database inside the IN but the invention fails to illustrate a database in the IN in the application. It is clear from the specification that there is some database and this database keeps an updated list of gateways, a list of IP-addresses and area codes, as recited in claim 7. It is clear from claim 6 that these lists are used by a process for finding the most appropriate gateway and this process is carried out in the IN. Therefore, there is some database in the IN of the invention even though a database is not illustrated in the application.

Specification

5. It is noted that an abstract was published with the international application under PCT Article 21.
6. The abstract of the disclosure is objected to because it is too vague. Correction is required. See MPEP § 608.01(b).

Regarding the published abstract that was submitted along with the international application, it is one-sentence long: The present invention relates to a method for

improving the setup of telephone-to-telephone calls using telephones connected to a PSTN/ISDN access network, especially Internet as a substantial by-pass network, special telephone gateways (GW) forming bridges between the access network and said by-pass network, and connections being established between the user telephones (A, B) and the gateways (GW) that bridge the call, and for the purpose for handling call establishment in only one phase, as well as making use of associated Intelligent Networks more efficiently, it is according to the present invention suggested that for the purpose of making the gateways transparent to the caller (A), the method allows the caller (A) to dial a by-pass network service prefix together with the number of the callee (B). The concept is disclosed because basic to the science of Internet telephony, this invention uses the Internet to bypass a public switched telephone network or integrated service digital network (PSTN/ISDN) for the telephones. See *Architecture and Protocols for IN/INTERNET Interworking*, Mi Zhengkun, ICCT'98, Proceedings of the International Conference on Communication Technology, 22-24 Oct. 1998, Section 2. ("Conceptually, there are 4 classes of services related to PSTN/ISDN and Internet interworking. . . . Phone to phone: using Internet as intervening network"). The novelty of the invention is mentioned vaguely, e.g. "making use of associated Intelligent Networks more efficiently." It is noted that the invention is making use of intelligent network(s) and is a way of improving the bypass process between PSTN/ISDN and Internet networks. "The crucial question, which remains largely unanswered, is whether these community networks, as currently envisioned by their sponsors, are merely means to deliver specific services or are part of a more general communications

infrastructure.” *Services or Infrastructure: Why We Need a Network Service Model*, Scott Shenker, David D. Clark, and Lixia Zhang, Proceedings of the 1st International Workshop on Community Networking Integrated Multimedia Services to the Home, 13-14 July 1994, p.145.

Claim Objections

7. Claims 8, 9 and 10 objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should not depend on another multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims 8, 9 and 10 not been further treated on the merits.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claim 2, 3, 4, 5 and 6 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claim 2, neither the claim language nor the specification provides “the manner and process of making” the most appropriate gateway. Claim 2 suggests that

the most appropriate is the closest gateway. The closest gateway is found by analyzing the caller's number, and/or possibly route the call to an alternative gateway if the closest is busy, etc. Call's number is only an element to find the most appropriate gateway.

Claim 2 fails to show how the element find the closest gateway, how to detect busy, and how to determine alternative gateway. Moreover, it is unclear and insufficient to give one example of "the most appropriate" in claim 2 because the phrase is also used in claims 3, 6 and 10. Claim 2 first suggests "the most appropriate" is the closest gateway. Claim 3 is a dependent claim on claim 2 and claim 6 is a dependent claim on any of the preceding claims. Therefore, the most appropriate gateway referenced in claims 3 and 6 is the closest gateway. However, claim 10 does not suggest that the most appropriate gateway is the closest gateway. Claim 10 is a multiple dependent claim and suggests that the most appropriate gateway or gateways is/are selected "according to the quality of service require, or possibly according to other criteria, for example tariff, availability, etc." See also *Architecture and Protocols for IN/INTERNET Interworking*, Mi Zhengkun, ICCT'98, Proceedings of the International Conference on Communication Technology, 22-24 Oct. 1998, Section 4. ("The following issues are special for Internet and need to be considered: Time delay . . . Delay variation . . . Robust restoration of information . . . Bandwidth utilization efficiency . . .") Cf. Farris et al. (U.S. Pat No. 6,574,216) discloses a packet data network voice call quality monitoring.

Regarding claim 3, neither the claim language nor the specification provides "the manner and process of making and using" a number pattern. Claim 3 suggests that there is in the call set-up, the associated gateway number as destination number, as

well as the caller number and the callee number in the call set-up. The three numbers are only elements in the call set-up. Claim 3 fails to show how the elements set up the call and how the numbers are delivered during the call set-up.

Regarding claim 4, neither the claim language nor the specification provides "the manner and process of making and using" address analysis. Claim 4 suggests that address analysis is carried out in the gateway to which the call has been routed. Claim 4 fails to show what is an address analysis, how it is used, and where it is in the overall method.

Regarding claim 5, neither the claim language nor the specification provides "the manner and process of making and using" number analysis. Claim 5 suggests that number analysis is coupled with other services. Claim 5 fails to show what is a number analysis, how it is used, and where it is in the overall method. Moreover, the limitation "other services" is overly broad and the examples are few and non-descriptive. A defined set or a descriptive class of other services is suggested.

Regarding claim 6, neither the claim language nor the specification provides "the manner and process of making and using" a process for finding the most appropriate gateway. Claim 6 suggest a process for finding the most appropriate gateway for any terminating callee number is carried out in the intelligent network, i.e. by finding the E.164 number to an appropriate gateway, as well as the IP address to the gateway. The E.164 number and IP address are only elements in the process. Claim 6 fails to show how to achieve this process using these elements and where is this process in the overall method.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

11. Claim 1 rejected under 35 U.S.C. 102(a) as being anticipated by Smyk (U.S. Pat No. 6,597,686).

Regarding the characterization and limitations in claim 1, Smyk discloses the calling party in a one-step procedure Fig. 9 dials a by-pass network service prefix together with the number of the called party 702,704 i.e. a prefix 704 (calling party's preference number; see col. 5, ln. 48-65) + B-number 702 (called party's telephone number). Smyk also discloses that said by-pass network service prefix is analyzed 806 (analyze signal and query SCP) to identify the relevant IN service 810 (should the call be routed via STN or Internet) for thereby routing the call to an IN node which can execute this IN service 812,824 (SCP notifies POP's gateway about the incoming call and queries the gateway for assigned RN, SCP sends 'continue' to switch to route call via PSTN), the IN service establishes the call to an appropriate gateway 818 (established call between caller's phone and the gateway), which means that the gateway is made service transparent 820 (POP's gateway connects the call to the called party) to the calling party 822 (call established between the calling party and the called party). Fig. 7 and 8.

Allowable Subject Matter

12. Claim 7 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Farris (U.S. Pat No. 6,292,478) discloses a telecommunications system. Fig. 3 and 4 show simplified flow diagrams of one mode of operation of the system of Fig. 1. In Fig. 3, the first step 100 dials a prefix.

Farris (U.S. Pat No. 6,546,003) discloses a telecommunications system. Farris uses the PSTN and the Internet. Farris keeps a centralized directory number database to offer directory assistance to callers.

Miloslavsky (U.S. Pub. No. US2001/0043586) discloses an apparatus and methods enhancing call routing to and within call-centers. Fig. 4 shows a process flow diagram depicting steps in a process according to another preferred embodiment. In Fig. 4, the third step 417 determines best-fit destination for the call.

Miloslavsky (U.S. Pat No. 6,449,270) discloses a dynamic re-routing. The routing processor forwards incoming calls to remote computer stations. If a signal is not

Art Unit: 2667

received that the call is answered in a predetermined amount of time, the call is canceled and re-routed.

Voit (U.S. Pat. No. 6,075,783) discloses an Internet Phone to PSTN Cellular PCS System. The invention combines the capabilities of the Advanced Intelligent Network with the Internet. Fig. 2 shows a Domain Name System 13. Fig. 3 shows a detailed diagram, including an address table lookup and IP address register.

White et al. (U.S. Pat. No. 6,069,890) discloses an Internet telephone service. White is a system and method for providing telephone type services over the Internet without access to computer equipment, without the necessity of maintaining a subscription to any Internet service, and without Internet literacy.

Zhao et al. (U.S. Pat No. 6,529,501) discloses a method and apparatus for Internet telephony. In the apparatus, Zhao has a database containing a plurality of telephone numbers and a corresponding plurality of network addresses. The telephony method includes querying and address mapping server for a destination address.

Low (U.S. Pat No. 6,282,281) is a method of providing telecommunications services. Low improves the traditional IN for use only by the PSTN by placing the service logic and data on servers accessible over the Internet. Low is similar to PCT/GB96/03049 submitted by the applicant.

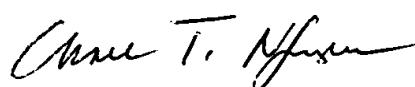
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blanche Wong whose telephone number is 703-305-

8963. The examiner can normally be reached on Monday through Friday, from 830am to 530pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chi H Pham can be reached on 703-305-4378. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-9600.

BW:bw



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